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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/721,450

11/25/2003

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EXAMINER

ONEILL, KARIE AMBER

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/721,450	<b>Applicant(s)</b> BREEN ET AL.	
	<b>Examiner</b> Karie O'Neill	<b>Art Unit</b> 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The Applicant's amendment filed on February 28, 2008, was received. Claim 51 was amended. Claims 1-28 have been cancelled. Claims 29-50 have been withdrawn from consideration. No new claims have been added. Therefore, Claims 51-54 are pending in this office action.

#### ***Claim Rejections - 35 USC § 112***

2. The rejection of Claim 51 under 35 U.S.C. 112, second paragraph, is overcome based on the amendments to the claim.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 51-52 are rejected under 35 U.S.C. 102(e) as being anticipated by Kunimoto et al. (US 7,160,643 B2).

With regard to Claim 51, Kunimoto et al. discloses in Figures 6 and 7, a battery powered device or a motor vehicle such as a hybrid car (column 3 lines 57-59),

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comprising: a chassis, or a casing (70); a battery bay, or lower portion (71) defined by the chassis; and the battery assembly comprising a plurality of battery subassemblies (10) that are operable to be mechanically mated and electrically coupled together to form the battery assembly (column 2 lines 12-29 and column 3 lines 61-67), the plurality of battery subassemblies (10) comprising: a first subassembly having a mating surface including a first pattern for mating engagement with a second subassembly having a mating surface including a second pattern, which is an inverse pattern to the first pattern, to resist relative movement between the first and second subassemblies when the mating surfaces are engaged to form the battery assembly (see Figures 5 and 7 and column 9 lines 55-67 and column 10 lines 1-7). Claim 51 is drawn to a product. The phrase “a battery assembly being removed from the battery bay during shipping to a user and being inserted in the battery bay after receipt by the user to avoid increased shipping fees” is functional language that imparts intended use on to the structural features of the product claim. Therefore, while the intended use language of the claim has been considered, it is not given patentable weight because it is directed to a process and not directed to the structural features of the product. Kunimoto et al. teaches a battery powered device, a chassis, a battery bay and battery subassemblies, which is the same structure as that claimed. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). A claim containing a “recitation with respect to the manner in which a claimed apparatus is

intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

With regard to Claim 52, Kunimoto et al. discloses wherein the first battery subassembly exhibits a first cell chemistry and the second battery subassembly exhibits a second cell chemistry, wherein the first cell chemistry is different from the second cell chemistry. The secondary batteries (10) can be any type of rechargeable battery, such as a nickel metal hydride battery, a lithium ion secondary battery and a nickel cadmium battery (column 4 lines 18-25).

### ***Claim Rejections - 35 USC § 103***

5. The rejection of Claims 51-54 under 35 U.S.C. 103(a) as being unpatentable over Osaka (US 5,628,054) and in view of Rasmussen et al. (US 2003/0167244 A1), as evidenced by Wehmeyer, have been overcome based on the amendments to the claims.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 53-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunimoto et al. (US 7,160,643 B2), as applied to Claims 51-52 above, and in further view of Verbrugge et al. (US 7,324,902 B2).

Kunimoto et al. discloses the battery powered device as described in paragraph 4 above, but does not disclose that the battery powered device comprises an information handling system, whereby the information handling system comprises a processor located in the chassis and a memory located in the chassis and coupled to the processor.

Verbrugge et al. discloses a battery pack for operating a hybrid electrical power train for a vehicle, the battery pack having secondary/rechargeable batteries such as lead acid, nickel metal hydride and lithium ion batteries (column 1 lines 9-11 and column 2 lines 52-55). The vehicle power train control system includes a battery pack, a controller monitoring the state of charge and a state of health of the battery pack and program product for computing the state of charge of the battery associated with the controller (column 4 lines 20-25). Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to use an information handling system with the battery powered device of Kunimoto et al., because Verbrugge et al. teaches monitoring the state of charge and state of health of the battery pack helps to assess the increase in irreversible losses that is inherent in the aging of batteries (column 2 lines 29-32).

***Response to Arguments***

8. Applicant's arguments with respect to the rejection of Claims 51-54 under 35 U.S.C 103(a) have been considered but are moot in view of the new ground(s) of rejection. The amendments to the claims have overcome the previous rejections in the office action dated November 30, 2007.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karie O'Neill whose telephone number is (571)272-

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8614. The examiner can normally be reached on Monday through Friday from 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Karie O'Neill  
Examiner  
Art Unit 1795

KAO

/Mark Ruthkosky/

Primary Examiner, Art Unit 1795